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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,907

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Koji Miyagawa

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09/15/2009

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EXAMINER

SHIBRU, HELEN

ART UNIT

PAPER NUMBER

2621

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09/15/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,907	<b>Applicant(s)</b> MIYAGAWA ET AL.	
	<b>Examiner</b> HELEN SHIBRU	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 17-19 is/are rejected.
- 7) ☒ Claim(s) 9-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/07/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 12-16 and 18-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 09/02/2009.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kikuchi (EP 1, 195, 766).

Regarding claim 1, Kikuchi teaches a recording apparatus for recording contents, said recording apparatus comprising: a drive unit operable to have a portable recording medium removably attached (see figure 1, unit 1001, and paragraph 0069); a relief recording medium (claim 2 and figure 1, unit 2001); an obtaining unit operable to obtain specification information which specifies one or more portable recording media to be used for recording a content (see paragraphs 0073-0076 and figure 1); a recording control unit operable to perform control so that (i) in a case where one of the specified portable recording media is attached to said drive unit when the content is to be recorded, the content is recorded onto the attached portable recording medium (see abstract, claim 1 and paragraphs 0057-0059), and (ii) in a case where none of the specified portable recording media are attached to said drive unit when the content is to be

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recorded, the content is recorded onto said relief recording medium (see abstract, claim 10 and paragraphs 0088-0090; and a dubbing control unit operable to, in a case where one of the specified portable recording media is attached to said drive unit after the content has been recorded onto the relief recording medium, dub the recorded content from said relief recording medium onto the one of the specified portable recording media (see paragraphs 0071-0072 and 0098-0099).

Regarding claim 2, Kikuchi discloses the specification information specifies one portable recording medium, using a piece of identification information which uniquely identifies the one portable recording medium; and said recording control unit judges that the specified portable recording medium is attached to said drive unit when a currently attached portable recording medium is identified with the piece of identification information (see claim 10 and paragraphs 0067-0070).

Regarding claim 3, Kikuchi discloses the specified portable recording medium has the piece of identification information recorded thereon; and said recording control unit makes the judgment by comparing the piece of identification information recorded on a currently attached portable recording medium with the piece of identification information used by the specification information (see paragraphs 0079-0082 and claim 11).

Regarding claim 4, Kikuchi discloses the specification information specifies the one or more portable recording media, using a piece of identification information that identifies a group made up of the one or more portable recording media; and said recording control unit judges that one of the specified portable recording media is attached to said drive unit when a currently

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attached portable recording medium belongs to the group identified with the piece of identification information (see paragraphs 0079-0083).

Regarding claim 5, Kikuchi teaches each of the one or more specified portable recording media has the piece of identification information recorded thereon, the piece of identification information showing the group to which each recording medium belongs; and said recording control unit makes the judgment by comparing the piece of identification information recorded on a currently attached portable recording medium with the piece of identification information used by the specification information (see paragraphs 0105-0109).

Regarding claim 6, Kikuchi teaches a list storing unit that stores a list showing the one or more specified portable recording media belonging to the group (see paragraph 0115); wherein said recording control unit makes the judgment by referring to the list (see paragraphs 0096-0117).

Regarding claim 7, Kikuchi teaches obtaining unit is further operable to obtain time information which indicates a time at which the content is broadcasted as a broadcast program, and the recording control unit performs the control so that the content is recorded at the time indicated by the time information (see paragraphs 0101-0102).

Regarding claim 8, Kikuchi teaches the obtaining unit obtains the specification information and the time information based on a piece of preprogramming information provided by a user who preprograms the recording of the content (see paragraph 0104-0106).

Regarding claims 17-19, the limitations of claims 17-19 can be found in claim 1 above. Therefore claims 17-19 are rejected for the same reasons as discussed in claim 1.

***Claim Rejections - 35 USC § 101***

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4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18, is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim recites a program and the program is a signal and therefore it is non-statutory.

*Allowable Subject Matter*

5. Claims 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 9, the Prior Art fails to teach or suggest apparatus of claim 1 including the specification information specifies one portable recording medium; a piece of preset information is recorded on the specified portable recording medium, the piece of preset information instructing that the content should be recorded and including the time information; and when the piece of preset information is read from the portable recording medium, the obtaining unit obtains (i) the specification information for instructing that the content should be recorded onto the portable recording medium having the piece of preset information, and (ii) the time information included in the piece of preset information.

Regarding claims 10-11, claims 10-11 are objected as being dependent upon the objected claim.

*Conclusion*

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HELEN SHIBRU/  
Examiner, Art Unit 2621  
September 12, 2009

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621